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Klaus Moritzen

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HARNESS, DICKEY & PIERCE, P.L.C.

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EXAMINER

MCINTYRE, CHARLES AARON

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,517	Applicant(s) MORITZEN, KLAUS	
	Examiner C. Aaron McIntyre	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-90, 103 and 104 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-90, 103 and 104 is/are rejected.
- 7) ☒ Claim(s) 83 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This final Office action responds to the amendment and arguments filed by Applicants on 17 March 2009 in reply to the previous Office action on the merits, mailed 14 January 2009.
2. Claims 1-14, 16-90, and 103-104 are pending in this application and have been examined.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 IV. and its discussion of 37 C.F.R. §1.75(d)(1). Correction or appropriate clarification of the following claim limitations is required:

- a. “means for examining licensing information” as recited in claim 60.
- b. “means for comparing information identifying a machine” in claim 60.
- c. “means for determining a number of uses” in claim 60.
- d. “means for granting the license for use” in claim 60.
- e. “means for examining validity of the software license” in claim 61.
- f. “means for prohibiting at least one of operation...” in claim 62.

Claim Objections

4. Claim 83 is objected to because of the following informalities: It appears that “The apparatus of claim 78” was intended to be --The method of claim 78-- because claim 78 is

simply not an apparatus claim. This apparatus to method change will be assumed for purposes of further consideration of the claims, as to the merits, herein below.

5. Appropriate correction is required.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3, 6-8, 10-11, 13-14, 16-29, 32, 35-37, 39-40, 42, 45-59, 62, and 77 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 3, the claimed limitation “prohibit at least one of operation of the software and operation of the machine using the software” is indefinite. It is unclear how Applicants intend for the machine to be prohibited from operating. There are multiple mutually exclusive possibilities regarding what precisely is being prohibited. The machine may be prohibited from operating entirely, prohibiting operation of the machine with respect to the license, or prohibiting the machine from using the software. Therefore, to one of ordinary skill in this art—the metes and bounds of the phrase cannot be reasonably determined.

9. The Examiner respectfully recommends adding language such as the device will prohibit operation of the machine “with respect to the license” from ¶ 0049 of Applicant’s Pre-Grant Publication No. 2005/0165693. This language will still permit the machine to operate, which the

Examiner finds cannot be prevented by Applicants' invention, thereby making the claims definite.

10. The analysis of claim 3 applies to the similar limitations present in rejected claims 6, 8, 18, 21, 23, 32, 35, 37, 45, 47, 62

11. Regarding claims 16, the claimed limitation "computer-readable medium containing instruction executable on a computer" followed by the two limitations "first code segment stored in a computer device of a user machine" and "second code segment stored in a computer device of a user machine" is indefinite. It is unclear where the two code segments are being stored because they can be stored in the medium as evidenced by the preamble, or in the computer device as evidenced by the limitations in the body of the claim. Therefore, to one of ordinary skill in this art—the metes and bounds of the phrase cannot be reasonably determined.

12. All other claims in the statement of rejection depend from one of the claims discussed above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-11, 16-26, 30-40, 44-49, 51-64, 66-90, and 103-104 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0205261 to Osada in view of U.S. Patent No. 6,708,157 to Stefik et al., hereinafter referred to as Stefik.

15. Regarding **claims 1, 16, 30 and 103**, Osada discloses a licensing method, system, and computer readable medium ("*license management module*" [abstract]), comprising:

16. storing licensing information ("*FIG. 11 is a diagram showing part of the contents of licensing conditions*" [0040]; [fig. 11]) on a storage device ("DISK 204" [fig. 2]; "*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*" [0108]) in the user machine ("*image forming apparatus 100 (MFP) is comprised of a controller 101*" [0058]; [fig. 1]), the licensing information ("*licensing*" [0040]) including at least one use of software ("*Total Print Surface Count*" [fig. 11]) of software ("*software of the controller 101*" [0070]; [fig. 1]) on the user machine ([fig. 1]), the information being unique and unchangeable information identifying the machine ("*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*" [0088]; [fig. 11]; "*apparatus identification information 800*" [0083]; [fig. 9]), and information for measuring a number of uses of the software on the machine ("*The total print surface count 84 is license information indicative of the total number of print surfaces that can be used*" [0080]; [fig. 8]; "*Total Print Surface Count 1005*" [fig. 11]); and

locally granting a license ("*acquires license information*" [0013]; "*transmitting the license information inputted by the operation of the operator*" [0016]) for the number of uses ("*Total Print Surface Count 1005*" [fig. 11]) of the software ("*software of the controller 101*"

[0070]; [fig. 1]) on the user machine (“*image forming apparatus 100*” [0058]; [fig. 1]), based upon the stored information (“*storage device that holds the license information*” [0015]; “*license information*” [0016]).

17. Additionally regarding **claim 1**, Osada discloses a storage medium (“*a storage medium*” [0012]) and a device in the machine for locally granting a license (“*License Management Module 503*” [fig. 5]).

18. Additionally regarding **claims 16**, Osada discloses a first code segment (“*Used Resources Totalizing Module 504*” [fig. 5]) and a second code segment (“*License Management Module 503*” [fig. 5])

19. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

20. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

21. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

22. Regarding **claims 2, 17, and 31**, Osada discloses wherein the step of locally granting the license (“*FIG. 20 is a flowchart of a determination process executed by the license management module*” [0049]; [fig. 20]; [fig. 5]) includes counting a number of uses of the software on the

machine (“it is determined in a step S1905 whether or not the total print surface count has exceeded its limit” [0124]; [fig. 20]; [0049]).

23. Regarding **claims 3, 18, and 32**, Osada discloses prohibiting at least one of operation of the software (“*abnormal termination*” [0129]) and operation of the machine using the software (“*abnormal termination*” [0129]) upon the count reaching [a limit] (“it is determined in a step S1905 whether or not the total print surface count has exceeded its limit” [0124]; step S1905 and “*Error Termination*” step S1910 [fig. 20]).

24. But Osada does not explicitly disclose the limit being zero.

25. However, it is admitted prior art that a limit could be zero because often systems count down instead of up.

26. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included a limit of zero, in accordance with the admitted prior art, in order to provide an alternative system with the ability to count down instead of counting up.

27. Regarding **claims 4, 19, 33, 46, and 61**, Osada discloses checking/examining validity of the software license during at least one of start-up and shut-down of the machine (“*Each of all the program modules managed by the start program management data table 600 requests the license management module 503, before starting a process that uses resources, to determine whether the process can be started*” [0121]; [fig. 20]).

28. Regarding **claims 5, 7, 20, 22, 34, and 36**, Osada discloses wherein the step of locally granting the license includes comparing the stored unique and unchangeable information to actual information identifying the machine on which the software will be used (“*when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match*” [0013]; [0083]).

29. Regarding **claims 6, 8, 21, 23, 35, 37, 47, and 62**, Osada discloses prohibiting at least one of operation of the software (“*abnormal termination*” [0129]; “*Error Termination S1508*” [fig. 16]) and operation of the machine using the software (“*abnormal termination*” [0129]; “*Error Termination S1508*” [fig. 16]) upon determining that the comparison does not match (“*Apparatus ID’s Match? S1503*” [fig. 16]; [0112]).

30. Regarding **claims 9, 10, 11, 24, 25, 26, 38, 39, 40, 48, 49, 63, and 64**, Osada discloses wherein at least a portion of the stored information is encrypted (“*Preferably, the license information comprises encrypted information*” [0023]).

31. Regarding **claims 44, 60, and 104**, Osada discloses a method, apparatus, and computer readable medium for granting a license on a machine (“*license management module*” [abstract]; [fig. 1]; [fig. 5]), comprising:

examining licensing information (“*license management device comprising a license information holding device that holds the license information associated with each of programs*”

set to a program to be executed at the start of the image forming apparatus” which it examines [0021-0022]) on a designated machine (“image forming apparatus” [0021]), the licensing information including information on a use of software (“license information associated with each of programs” [0021-0022]), including a number of uses of the software (“usage limit” [0022]; [fig. 11]) and unique and unchangeable information identifying the designated machine (“apparatus identification information 800” [0083]; “Serial Number 1001” [fig. 11]);

comparing (“match” [0013]) information identifying a machine to the unique and unchangeable information identifying the designated machine (“when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match” [0013]; “apparatus identification information 800” [0083]; “data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100” [0088]; [fig. 11]; [fig. 9]);

determining (“determining” [0124]) a number of uses of the software on the machine and comparing the number of uses to the number of [limited] uses (“it is determined in a step S1905 whether or not the total print surface count has exceeded its limit. This determination is carried out by comparing the total print surface count 84 associated with the relevant module ID in the management information 80 with the total print surface count 1802 associated with the relevant module ID in the used resources totalizing table 1800 held by the used resources totalizing module 504, and determining, based on the result of the comparison, whether or not the total print surface count has exceeded its limit” [0124]; [fig. 20]; [0049]); and

granting the license (“*acquires license information*” [0013]; “*transmitting the license information inputted by the operation of the operator*” [0016]) for use (“*Total Print Surface Count 1005*” [fig. 11]) of the software (“*software of the controller 101*” [0070]; [fig. 1]) on the machine (“*image forming apparatus 100*” [0058]; [fig. 1]) for the number of uses remaining (difference between “*total print surface count 84*” and “*total print surface count 1802*” [0124]) upon the information identifying the machine matching (“*match*” [0013]) the unique and unchangeable information identifying the designated machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; [fig. 9]) and upon the number of uses being determined to be less than the number of prepaid uses (“*determining*” [0124]; *S1905* [fig. 20]; “*Normal Termination S1908*” [fig. 20]).

32. Additionally regarding **claim 104**, Osada discloses stored on a storage device (“*DISK 204*” [fig. 2]; “*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*” [0108]).

33. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

34. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

35. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance

with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

36. Regarding **claim 45**, Osada discloses prohibiting at least one of operation of the software (“*abnormal termination*” [0129]) and operation of the machine using the software (“*abnormal termination*” [0129]) upon the number of uses being determined to be at least equal to the number of uses (“*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit*” [0124]; *step S1905 and “Error Termination” step S1910* [fig. 20]; *with exceeding its limit inherently, as in necessarily being the same as equaling the number of uses allowed*).

37. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*).

38. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

39. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

40. Regarding **claims 51, 66, and 84**, Osada discloses determining a number (“*the result of the comparison*” [0124]) of uses of the software remaining (“*whether or not the total print surface count has exceeded its limit*” [0124]).

41. Regarding **claims 52, 67, and 85**, Osada discloses determining a number (“*the result of the comparison*” [0124]) of uses of the software remaining (“*whether or not the total print surface count has exceeded its limit*” [0124]) and indicating (“*status indicative*” [0128]) the number of remaining uses on the machine (“*notification of used resources and the used resources totalizing table*” [0118]; *when there are no remaining uses, “a status indicative of abnormal termination of the present process is set in a step S1910”* [0128]; [fig. 20]).

42. Regarding **claims 53, 68, and 86**, Osada discloses determining a number (“*the result of the comparison*” [0124]) of uses of the software remaining (“*whether or not the total print surface count has exceeded its limit*” [0124]) and providing an indication on the machine (“*status indicative of abnormal termination*” [0128]) upon determining that the number of remaining uses exceeds a threshold (“*when there are no remaining uses, “a status indicative of abnormal termination of the present process is set in a step S1910”* [0128]; [fig. 20]).

43. Regarding **claims 54, 56, 69, 70, 87, and 89**, Osada discloses wherein the indication includes a visual indication (“*FIG. 14A or the screen 1303 shown in FIG. 14B is displayed according to the result of the process*” [0105]; [figs. 14A-14B]; “*status line 1140*” [0100]; “You Can Copy” “1 Sheet(s)” [fig. 12]).

44. Although it is the Examiner's principle position that Osada discloses a visual indication, if it is not clear enough then the Examiner's alternative position is that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included displaying this information in the status line, in accordance with the further teachings of Osada, in order to provide greater functionality by providing the user with an indication of the status.

45. Regarding **claims 55, 57, 58, 59, 71, 72, 73, 74, 88, and 90**, Osada discloses as discussed above. But Osada does not explicitly disclose wherein the indication includes an audible indication.

46. However, it is admitted prior art to use audible indications or alerts.

47. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the indication includes an audible indications, in accordance with the admitted prior art, in order to increase the audience capable of using the device, such as to a visually impaired person who cannot easily see the tiny display in Osada..

48. Regarding **claims 75, 77, 78, 80, and 82**, Osada discloses wherein the information on storage medium is a software option ("*when the option is a software one*" [0007]; "*license management device*" [0013]).

49. Regarding **claim 76, 79, 81, and 83**, Osada discloses wherein the storage medium stores both the software and the software option (“*storage device that stores ... a plurality of programs ... and a license management device that permits use of the plurality of programs*” [0013]).

50. Claims 12, 13, 14, 27, 28, 29, 41, 42, 43, 50, and 65, are rejected under 35 U.S.C. 103(a) as being unpatentable over Osada in view of Stefik in further view of U.S. Patent No. 6,816,842 to Singh et al., hereinafter referred to as Singh.

51. Regarding **claims 12, 13, 14, 27, 28, 29, 41, 42, 43, 50, and 65**, Osada discloses as discussed above. But Osada does not explicitly disclose wherein the machine is a medical device.

52. However, Singh teaches wherein the machine is a medical device (“*medical imaging equipment*” [col. 1, ll. 13-25]).

53. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the machine is a medical device, in accordance with the teaching of Singh, in order to increase profits by providing a wider range of computer devices upon which the licensing method could be implemented.

54. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

35 USC § 112 6th Paragraph

Means Phrase #1

Invocation:

55. It is the Examiner's position that in claim 60, the phrase “means for examining licensing information” (“Means Phrase #1”) is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of “means for” from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6th paragraph should not be invoked.

Invocation Step 1:

56. First, in accordance with the MPEP §2181, *the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6 ¶* (“Guidelines”), and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d. 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999), Applicants' use of “means for” in claim 60 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6th paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which 35 U.S.C. 112 6th paragraph applies. Since “means for” is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

57. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner's position that Applicants recite a corresponding function to the means, "examining".

27. The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Here, the function as found in the Means Phrase #1 will have their ordinary meaning.

Invocation - Step 3:

58. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

59. In this case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation--only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). The "means for examining" can not be entirely performed by the little if any recited structure in the claim.

60. Because of the above, it is the Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Corresponding Structure, Material, or Acts

61. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Id.*

62. In this case, the corresponding structure, as found in fig. 3 of Applicants' Pre-Grant Publication, expanded upon in ¶¶ 0047-0049, and further evidenced by Applicants' March 2009 Remarks, is present in a general device as illustrated by device 6 in fig. 3.

63. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure of Means Phrase #1 to be hardware alone. In other words, the corresponding structure of Means Phrase #1 does not include any software.

64. In short, the Examiner finds the corresponding structure of Means Phrase #1 to be the structure of a general device.

65. The Examiner will next apply the above reasoning to all claimed phrases that potentially invoke 35 U.S.C. 112 6th paragraph. Citations and authorities will be omitted for clarity.

Means Phrase #2

66. It is the Examiner's position that the “means for comparing information” in claim 60 (“Means for Phrase #2”) invokes 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #2 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #2 meets Invocation Step 2 because the phrase recites the function of “comparing.” This function will have its ordinary and plain meaning.
- c. Means for Phrase #2 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “comparing”.
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #3

67. It is the Examiner's position that the “means for determining a number of uses” in claim 60 (“Means for Phrase #3”) invokes 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #3 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #3 meets Invocation Step 2 because the phrase recites the function of “determining.” This function will have its ordinary and plain meaning.
- c. Means for Phrase #3 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “determining”.

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #4

68. It is the Examiner's position that the “means for granting the license” in claim 60 (“Means for Phrase #4”) invokes 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #4 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #4 meets Invocation Step 2 because the phrase recites the function of “granting.” This function will have its ordinary and plain meaning.
- c. Means for Phrase #4 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “granting”.
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #5

69. It is the Examiner's position that the “means for examining validity” in claim 61 (“Means for Phrase #5”) invokes 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #5 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #5 meets Invocation Step 2 because the phrase recites the function of “examining.” This function will have its ordinary and plain meaning.

- c. Means for Phrase #5 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “examining”.
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #6

70. It is the Examiner's position that the “means for prohibiting at least one of operation...” in claim 62 (“Means for Phrase #6”) invokes 35 U.S.C. 112 6th paragraph.

- a. Means for Phrase #6 meets Invocation Step 1 because “means for” is recited.
- b. Means for Phrase #6 meets Invocation Step 2 because the phrase recites the function of “prohibiting.” This function will have its ordinary and plain meaning.
- c. Means for Phrase #6 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “prohibiting”.
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Response to Arguments

Applicants' Arguments Regarding 35 USC § 112 “prohibiting operation” phrase:

- 71. Applicants argue the claimed limitation “prohibit at least one of operation of the software and operation of the machine using the software” recited in at least claim 3 overcomes the 35

USC § 112 second paragraph rejection because “it is the device which prohibits operation of the machine and not the machine from prohibiting of itself.” Applicants’ March 2009 Remarks, p. 18.

Examiner's Response:

72. The Examiner respectfully disagrees.

73. It appears Applicants interpreted the rejection to mean the Examiner was overlooking the device. However, the Examiner was interpreting the claim as if the software itself was prohibiting operation. This interpretation of the rejection is moot however because one way or another, it is unclear how operation of the machine can be prohibited because the user can always simply reboot the machine, thereby causing the machine to operate again.

74. The Examiner has rephrased the 35 USC § 112 second paragraph rejection above to be more clear on what the precise indefiniteness is and the Examiner has provided suggested language which would overcome this rejection or at least provide guidance on what would be needed to overcome this rejection.

Applicants' Arguments Regarding “storage medium including licensing information”:

75. Applicants argue Osada does not disclose a “storage medium including licensing information” as recited in at least claim 1.

Examiner's Response:

76. The Examiner respectfully disagrees.

77. In particular, Osada discloses storing licensing information (“*FIG. 11 is a diagram showing part of the contents of licensing conditions*” [0040]; [fig. 11]) on a storage device (“DISK 204” [fig. 2]; “*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*” [0108]).

78. Osada explicitly states the licensing information can be stored in DISK 204 (“*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*” [0108]).

Applicants’ Arguments Regarding “prepaid”:

79. Applicants argue Stefik does not disclose “prepaid” as recited in at least claim 1.

Examiner’s Response:

80. The Examiner respectfully disagrees.

81. Stefik discloses prepaid (“*already paid for*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

82. Applicant’s attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20081231, ¶¶ 26 and 47) is inadequate. Adequate traversal is a two step process. First, applicants must state their traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires applicants to specifically point out the supposed errors in the Office Action, applicants must state *why* the Official Notice statements are not to be considered common knowledge or well known in the art.

83. In this application, the Applicant has not met step (2) because Applicants have failed to argue *why* the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicant's traversal is inadequate, the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

84. The above responses apply to the dependent claims by virtue of their dependencies on the independent claims. The above responses also apply to the corresponding elements in the corresponding independent claims.

Conclusion

85. Applicants' amendment filed 17 March 2009 necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

86. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

87. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401.

The Examiner can normally be reached on Monday to Thursday 9-6 ET.

88. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

89. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. M./
Examiner, Art Unit 3621
July 11, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621